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RTL Date: 3-25-04
Richard T. Lyon

PATENT
Microsoft Docket No. 130654.1
L&H No. MCS-020-99

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of
Cortright et al.

Group Art Unit: 2142

Entitled: ADDRESSES AS OBJECTS
FOR EMAIL MESSAGES

Examiner: L. L. Tran

Serial No.: 09/690,426

Filing Date: October 17, 2000

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AFTER FINAL RESPONSE

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Hon. Commissioner for Patents
P.O. Box 1450
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Sir:

In regard to the final Office Action dated January 28, 2004 (Paper No. 8), it is respectfully requested that the rejections be reconsidered.

The above-identified Office Action was a final rejection of Claims 1-25 of the referenced application. However, the application is believed to be in condition for allowance because the claims are not obvious over the cited art. As

such, the applicants hereby respectfully request further examination and reconsideration of the subject application. The reasons for this belief in the non-obviousness of the rejected claims are presented below.

The Section 103(a) Rejection of Claims 1-25

Claims 1-25 were rejected under 35 USC 103(a) as being unpatentable over Spencer, et al., U.S. Patent No. 6,349,299 (hereinafter Spencer) in view of Holtz et al., U.S. Patent No. 6,433,800 (hereinafter Holtz). It is contended in the Office Action that Spencer teaches all the elements of the rejected claims with the exception of marking the email address with an adjacently placed indicator. However, it is further contended that the Holtz reference teaches this feature. Thus, it was concluded that it would have been obvious to incorporate the Holtz teachings into Spencer to produce the applicants' claimed invention. The applicants respectfully disagree with this contention of obviousness as it is believed that the Holtz reference does not teach or suggest marking an email address with an indicator.

More particularly, the applicants claim a system and process that allows a user to treat email addresses found in incoming and outgoing emails as objects. As such the user can, for example, add them to a contact list, copy them to the computer's clipboard, or "double-clicked" to open the related contact information for that email address' sender, among other things. To facilitate this manipulation of the email addresses, a small indicator icon is added to the text of each address.

The cited combination on the other hand lacks any teaching or suggestion that the aforementioned icon be added to the text of the email address as a prerequisite to its manipulation as an object. It was stated in the Office Action that Spenser lacked such a teaching. Thus, in order to find the claimed invention obvious, this teaching must be found in the Holtz reference. However, nowhere in Holtz is it suggested that an email address be represented by an object icon or that

an object icon be displayed adjacent to an email address.

The Examiner contends that the Holtz does teach that an email address can be represented by an object icon and that this is taught at Col. 3, lines 8-9. The cited section of Holtz reads:

"Icons representing the addressing of the e-mail message and an attachment action are displayed upon the computer display device....
(emphasis added)

It is contended in the final Office Action that the foregoing passage teaches representing an email address with an object icon. However, this is not the case. Rather, this passage teaches the representation of an action as an icon—namely the task of addressing an email or attaching a file to an email. An object icon representing an email message (as opposed to an email address) can be dragged to the icon representing the addressing function. The email would then be acted upon in a conventional way to address it, presumably using an email address book program of some type. Similarly, an attachment file to an email would be represented by an icon, and this object icon could be dragged and dropped onto the action icon representing the task of attaching the file to the email.

Thus, Holtz does not specifically teach representing an email address with an icon or displaying an object icon adjacent to an email address. However, the Examiner appears to be contending that Holtz teaches the use of an icon to represent any object of any datatype, and so concluding this includes appending an object indicator to an email address. This is akin the situation where a prior art reference teaching a genus and an application claims a species of this genus (see MPEP 2144.08). However, to make out a prima facie case of obviousness, the prior art references must include some teaching or suggestion to motivate the choice of the particular species. Here no such teaching or suggestion exists in Holtz. In fact the teachings of Holtz would tend to do just the opposite. Holtz suggests datatypes

such as Microsoft Word® or Excel® files, which are going to be very large in comparison to an email address. The advantage of representing a large data file with an icon is that these files would be too large and cumbersome to display otherwise in the context of the Holtz invention. Conversely, an email address is typically quite short. Thus, the advantage of representing a large amount of data with an icon to facilitate its graphical manipulation would not apply to an email address. As such, nothing in the Holtz teaching would even suggest representing an email address using some kind of generic email datatype icon.

Further, there is no suggestion in Holtz that an object icon be appended to an email address. Holtz teaches that Microsoft Word® or Excel®, or analogously-typed objects, are sometimes represented by object icons. This is not the same as appending an indicator to the text of an email address. Granted, the Examiner further contends that even though Holtz does not expressly teach appending an object icon to an email address, this is obvious since icon-based operating systems are known to append an icon adjacent a name of the data object it represents. The Examiner appears to be contending that since icon-based operating systems have object icons displayed next to data object names, this teaches that object icons can be displayed adjacent the name of any object of any datatype, including appending an object indicator to an email address. Here again, this is the same as contending that when the prior art teaches a genus, any species of the genus is unpatentably obvious. As indicated previously, this is not the case. To make out a *prima facie* case of obviousness, the prior art references must include some teaching or suggestion to motivate the choice of the particular species. Thus, the mere fact that icon-based operating systems have icons placed adjacent data objects does not make displaying an object indicator adjacent an email address obvious without some suggestion to do so. However, the applicants are not aware of any icon-based operating systems where an email address has an appended object indicator.

In this case, neither Spencer nor Holtz (nor icon-based operating systems) teach or suggest the applicant's claimed feature of marking an email address with

an adjacently placed indicator, which upon selection by a user allows the manipulation of the address as an object. Thus, the applicants have claimed a feature not taught in the cited combination. Accordingly, no *prima facie* case of obviousness can be established. This lack of *prima facie* showing of obviousness means that the rejected claims are patentable under 35 USC 103 over Spencer in view of Holtz. As such, it is respectfully requested that the rejection of Claims 1-25 be reconsidered based on the non-obvious claim language,

"marking the email address with an adjacently placed indicator; and upon selection of the indicator by the user, allowing the user to manipulate the email address as an object".

Summary

In summary, it is believed that the claims are in condition for allowance. Accordingly, reconsideration of the rejection of Claims 1-25 is respectfully requested. In addition, allowance of these claims at an early date is courteously solicited.

Respectfully submitted,



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